

REMARKS/ARGUMENTS

I. General Remarks

At the time of the Office Action, Claims 18-67 were pending. Claims 18 and 35 are currently amended herein. Claims 68-75 have been added. Claims 20-24, 27, 30, 37-41, 44, 47, 50-64, and 67 are withdrawn.

Applicants respectfully request that the above amendments be entered and further request reconsideration of the application in view of the amendments and the remarks contained herein.

II. Remarks Regarding Restriction Requirement

In the present office action the Examiner stated:

The Examiner agrees with Applicants that claim 18 is generic to both independent claims 35 and 50 because a servicing fluid of claim 18 may be used as a fracturing fluid or for forming a gravel pack (See specification, P5). In other words, a servicing fluid is generic to two independent and distinct species of fluid. The Examiner will join claims 35-49, 65-66 (drawn to a fracturing fluid) to elected Group II, claims 18-27, and 30-34.

Claims 28-29 of Group I and claims 50-64, and 67 (drawn to forming a gravel pack) are withdrawn from consideration as directed to a **non-elected** invention. Claims 20-24, 27, 30, 44, [and] 47 are withdrawn from consideration as directed to a **non-elected species**. [emphasis in original].

(Office Action, page 2.) Applicants respectfully disagree with the statements made with regards to claims 28-29 and 50-64, and 67. First, Applicants would like to clarify that claims 50-64, and 67 are withdrawn from consideration as being directed to a non-elected species, rather than a non-elected invention. Thus, upon allowance of a generic claim, Applicants are entitled to the consideration of additional species which include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

Furthermore, the Examiner indicated that claims 28-29 are withdrawn from consideration as directed to a non-elected invention. Applicants respectfully disagree. Applicants designated claims 28-29 as falling within the elected group (Group II directed to a method of treating a subterranean formation) designated by Applicants. The Examiner has not issued any election requirement with respect to claims 28-29 and thus, has not shown why these claims should be withdrawn. Therefore, Applicants respectfully request reconsideration of the withdrawal of claims 28-29.

III. Remarks Regarding Rejections Under 35 U.S.C. § 102(b) and 103(a).

A. Claims 18-19, 25, 31-33, 35-36, 42, 45-46, 48-49, and 65-66

The Examiner has rejected claims 18-19, 25, 31-33, 35-36, 42, 45-46, 48-49, and 65-66 under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application No. 2002/0048676 issued to McDaniel, *et al* (hereinafter "*McDaniel*"). (Office Action at 3.) With respect to these claims, the Examiner states:

McDaniel et al disclose a method of treating a subterranean formation comprising providing a servicing fluid comprising low-density composite particulate proppant (See P62). It is the Examiner's position that pumping the servicing fluid into a subterranean formation is implied. McDaniel et al teach that a composite particulate comprises finely divided mineral or finely divided mineral and fiber, bound by suitable organic binder or inorganic binder (See P53). The composite particulates may comprise a low density filler material (such as ground walnut shells) together with a higher density filler material (such as finely divided silica), and a binder of polymer resin and cement, so long as the respective amounts of these ingredients results in a composite particle having the desired low density of 0.90 to 2.20 gm/cm³ (See P57). . .

(Office Action at 3-5.) Applicants respectfully disagree, and submit that the Examiner has not shown that *McDaniel* discloses or suggests every element as recited in claims 18-19, 25, 31-33, 35-36, 42, 45-46, 48-49, and 65-66 as required to anticipate the claims under 35 U.S.C. § 102(b), or to obviate the claims under 35 U.S.C. § 103(a). MPEP § 2131, 2142.

In particular, Applicants' amended independent claims 18 and 35 recite "providing a . . . fluid comprising reduced-density, coated particulates, wherein the reduced-density, coated particulates comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material." *McDaniel* does not disclose reduced-density, coated particulates that comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material. Rather, *McDaniel* discloses a composite particle comprising filler particles, e.g., finely divided mineral or finely divided mineral and fiber, bound by a

suitable organic or inorganic binder. (*McDaniel*, para. [0053].) Therefore, Applicants respectfully assert that independent claims 18 and 35 are not anticipated or obviated by *McDaniel*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 19, 25, 31-33, 36, 42, 45-46, 48-49, and 65-66 depend, either directly or indirectly, from claims 18 or 35, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

B. Claims 18-19, 32-33, 35-36, 49, and 65-66

The Examiner has rejected claims 18-19, 32-33, 35-36, 49, and 65-66 under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,493,8756 issued to Beck, *et al* (hereinafter “*Beck*”). (Office Action at 3.) With respect to these claims, the Examiner states:

Beck et al disclose a method of treating a subterranean formation comprising the steps of: providing a servicing fluid comprising reduced density coated particulate proppant (See column 1, lines 11-15, 57-68). It is the Examiner’s position that pumping the servicing fluid into a subterranean formation is implied. Beck et al teach that coating core particles with a reduced-density hollow microparticles can be carried out in a mixer (batch) (See column 2, lines 63-68) or by spray drying slurry of the core particles and the hollow microparticles in a binder solution (See column 3, lines 22-25).

It is the Examiner’s position that reduced-density coated particulate of Beck et al is substantially identical to that made by claimed-on-the-fly mixing, as opposed to batch or partial batch mixing,

(Office Action at 5.) Applicants respectfully disagree, and submit that the Examiner has not shown that *Beck* discloses or suggests every element as recited in claims 18-19, 32-33, 35-36, 49, and 65-66 as required to anticipate the claims under 35 U.S.C. § 102(b), or to obviate the claims under 35 U.S.C. § 103(a). MPEP § 2131, 2142.

In particular, Applicants’ amended independent claims 18 and 35 recite “providing a . . . fluid comprising reduced-density, coated particulates, wherein the reduced-density, coated particulates comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material.” *Beck* does not disclose reduced-density, coated

particulates that comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material. Rather, *Beck* discloses a proppant with a coating comprising hollow glass microspheres. (*Beck*, col. 2, line 55 - col. 3, line 7.) Therefore, Applicants respectfully assert that independent claims 18 and 35 are not anticipated or obviated by *Beck*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 19, 25, 31-33, 36, 42, 45-46, 48-49, and 65-66 depend, either directly or indirectly, from claims 18 or 35, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

IV. Rejections of Claims Under 35 U.S.C. § 103(a)

A. Claims 25, 42, and 45-46

Claims 25, 42, and 45-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Beck* in view of *McDaniel*. (Office Action at 5-6.) In order for a combination of references to form the basis for a rejection under § 103(a), the combination of references must teach or suggest all of the elements of the claim. MPEP § 2143.

As discussed in Section III above, *Beck* and *McDaniel*, alone or in combination, do not teach all the elements of independent claim 18 or 35, from which claims 25, 42, and 45-46 depend, because *Beck* and *McDaniel* do not, either explicitly or inherently, disclose or teach “providing a . . . fluid comprising reduced-density, coated particulates, wherein the reduced-density, coated particulates comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material.” Thus, these references do not obviate claims 25, 42, and 45-46. Accordingly, Applicants respectfully request the withdrawal of these rejections.

B. Claims 18-19, 25, 31-36, 42, 45-46, 48-49, and 65-66

Claims 18-19, 25, 31-36, 42, 45-46, 48-49, and 65-66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *McDaniel* in view of U.S. Patent No. 5,908,073 issued to Nguyen, *et al* (hereinafter “*Nguyen*”). In order for a combination of references to form the basis for a rejection under § 103(a), the combination of references must teach or suggest all of the elements of the claim. MPEP § 2143.

As discussed in Section III.A above, *McDaniel* does not teach all the elements of independent claim 18 or 35, from which claims 19, 25, 31-34, 36, 42, 45-46, 48-49, and 65-66 depend, because *McDaniel* does not, either explicitly or inherently, disclose or teach “providing a . . . fluid comprising reduced-density, coated particulates, wherein the reduced-density, coated particulates comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material.” Similarly, *Nguyen* fails to provide this missing recitation. Thus, these references do not obviate claims 19, 25, 31-34, 36, 42, 45-46, 48-49, and 65-66. Accordingly, Applicants respectfully request the withdrawal of these rejections.

C. Claims 18-19, 32-36, 49, and 65-66

Claims 18-19, 32-36, 49, and 65-66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Beck* in view of *Nguyen*. In order for a combination of references to form the basis for a rejection under § 103(a), the combination of references must teach or suggest all of the elements of the claim. MPEP § 2143.

As discussed in Section III.B above, *Beck* does not teach all the elements of independent claim 18 or 35, from which claims 19, 32-34, 36, 49, and 65-66 depend, because *Beck* does not, either explicitly or inherently, disclose or teach “providing a . . . fluid comprising reduced-density, coated particulates, wherein the reduced-density, coated particulates comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material.” Similarly, *Nguyen* fails to provide this missing recitation. Thus, these references do not obviate claims 19, 32-34, 36, 49, and 65-66. Accordingly, Applicants respectfully request the withdrawal of these rejections.

D. Claims 26 and 43

Claims 26 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *McDaniel/Beck* in view of *McDaniel/McDaniel* in view of *Nguyen/Beck* in view of *Nguyen*, further in view of U.S. Patent 4,665,988 issued to Murphey, *et al.* (hereinafter “*Murphey*”). In order for a combination of references to form the basis for a rejection under § 103(a), the combination of references must teach or suggest all of the elements of the claim. MPEP § 2143.

As discussed above, *Beck*, *McDaniel*, and *Nguyen*, alone or in combination, do not teach all the elements of independent claim 18 or 35, from which claims 26 and 43 depend,

because they do not, either explicitly or inherently, disclose or teach “providing a . . . fluid comprising reduced-density, coated particulates, wherein the reduced-density, coated particulates comprise a particulate material; a coating material; and a density reducing material comprising polystyrene divinylbenzene adhered to the coating material on an exterior surface of the particulate material.” Similarly, *Murphey* fails to provide this missing recitation. Thus, these references do not obviate claims 26 and 43. Accordingly, Applicants respectfully request the withdrawal of these rejections.

V. No Waiver


All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

SUMMARY

In light of the above remarks, Applicants respectfully submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with this filing. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0178.

Respectfully submitted,



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